



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/171,043	10/09/98	KONNERSMAN	P 08086/002002

GARY A WALPERT
FISH & RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804

TM02/1122

EXAMINER

LASTRA, D

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

11/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application N .

09/171,043

Applicant(s)

KONNERSMAN, PAUL M.

Examiner

DANIEL LASTRA

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 2764

Claims 1-7 have been examined.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In Figures 5,7 and 8, the term "Decision Manager" does not show a reference number. In Figure 9, the terms "producing" and "requiring" do not have a reference number. Correction is required.

Specification

2. The application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

3. The disclosure is objected to because of the following informalities: On page 17, line 13 "arc transitions" should read "are transitions". In page 20, line 14 the reference number "(120)" does not appear in Figure 5. On page 22, lines 3,15,20,31 and page 24, line 26, the reference "(105)" does not appear in any figure. On page 22, line 28 the reference "(110)" does not appear in any figure. On page 22, lines 25 and 28, "ia" should be "is". In page 23, lines 27-32, the term "Decision Manger" should read "Decision Manager". Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. The claims, as presently claimed and best

Art Unit: 2764

understood, were reconsidered in light of the new "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

Claims 2-7 do not recite a series of steps to be performed on a computer. The application's specification section does not recite a specific machine or manufacture, because the specification does not disclose specific hardware or software. "Specific software" is defined as a set of instructions implemented in a specific program code segment. See Computer Dictionary 78 (Microsoft Press, 2d ed. 1994) for definition of "Code segment." The present specification defines no such instructions. The invention is not implemented on a specific apparatus, and therefore, the invention is not directed to the technological arts. To be statutory, the utility of an invention must be within the technological arts. In re Musgrave, 431 F.2d at 893, 167 USPQ at 289-90, cited with approval in In re Schrader, 22 F.3d at 297, 30 USPQ 2d at 1461 (Newman, J., dissenting). The definition of "technology" is the "application of science and engineering to the development of machines and procedures in order to enhance or improve human conditions, or at least to improve human efficiency in some respect." (Computer Dictionary 384 (Microsoft Press, 2d ed. 1994). When one looks to the present specification to determine what Applicant has invented, the invention appears to be directed to the abstract method apart from the apparatus for performing the method. The claims are non-statutory because they are directed solely to an abstract idea without practical application in the technological arts. In re Schrader, 22 F.3d at 293-94,

Art Unit: 2764

30 USPQ 2d at 1458-59; In re Warmerdam, 33 F.3d at 1360, 31 USPQ 2d at 1759. For all the above reasons that claims 2-7 are deemed to be non-statutory.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is indefinite as it recites "utilizing messaging". For purpose of the following art rejection, the claim is being interpreted as nodes and arcs that are connected together with link lines.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being unpatentable by Nock (US 6,144,967).

As per claim 1, Nock teaches: "...supporting the work in process by rendering said process models as elements of a computer-based system and supporting the work

Art Unit: 2764

of the process by rendering said project models as elements of a computer-based system..." (see figure 1; description of the preferred embodiment)

As per claim 2, Nock teaches:

"...instantiating a plurality of objects by abstract or concrete classes, and including at least a decision class and a data class..." (see figure 2 and 7) and

"...relating each decision object to one or more data objects which it produces..." (see figure 5 and 7; and column 10, lines 47-55);

"...requiring, for at least one decision object, at least one data object as a prerequisite to its activation or completion..." (see figure 7 and column 10, lines 47-55);

"...optionally generating additional subclasses or instances of said decision and data classes..." (see figure 5);

As per claim 3, Nock teaches: "...comprising the step of relating an arc or link class linking a first decision with a second decision..." (see figure 2 and figure 7).

As per claim 4, Nock teaches:

"...generating a decision role class specialized into at least two subclasses, each with differing behaviors..." (see figure 4) and;

"...defining for each decision role class the communication requirements among the incumbents of roles participating in a decision, the rights of each such role class incumbents with respect to a) entering data elements in a database, b) modifying elements in a database and/or c) reading elements from a database..." (see column 10, lines 47-67 – column 11, lines 1-52).

As per claim 5, Nock teaches: "...utilizing messaging between said nodes and arcs and collections of said arcs and determining the membership of said collections by at least one of their entry nodes and exit nodes..." (see figure 5).

As per claim 6, Nock teaches: "...using a network whose nodes are abstract decision situations, and providing arcs directed by decisions based on logical precedence..." (see figure 2 and 5).

As per claim 7, Nock teaches: "...requiring nodes to support participation of multiple persons in differentiated roles..." (see figure 4).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McAtee et al (US 5,301,320) teach a method and apparatus for defining, executing, monitoring and controlling the flow of business operations.

Seidl (US 5,710,896) teach a method and apparatus for developing graphics applications, including a framework for handling the exchange of graphical data between applications and for presenting and manipulating graphical objects.

Art Unit: 2764

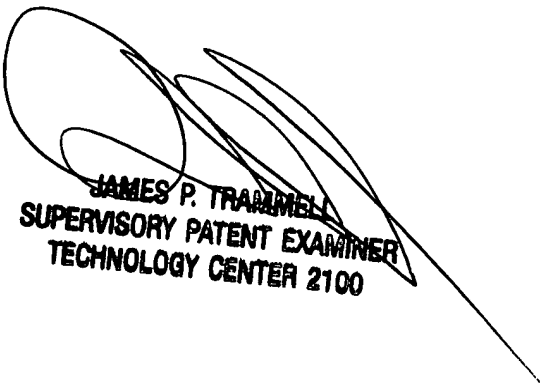
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached from 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES TRAMMELL can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-9051 for regular communications and 703-308-5357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

D.L.

Daniel Lastra
November 17, 2000



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100